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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION N
10/673,930	09/29/2003	Jeffrey S. Swayze	END5130.0517372	1635
26874	7590	10/01/2004	EXAMINER	
FROST BROWN TODD, LLC			WEEKS, GLORIA R	
2200 PNC CENTER			ART UNIT	
201 E. FIFTH STREET			PAPER NUMBER	
CINCINNATI, OH 45202			3721	

DATE MAILED: 10/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/673,930

Applicant(s)

SWAYZE ET AL.

Examiner

Gloria R Weeks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-19 and 24 is/are allowed.
- 6) ☒ Claim(s) 20-22 is/are rejected.
- 7) ☒ Claim(s) 23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/29/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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***Claim Objections***

1. Claims 10-13 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim 10. See MPEP § 608.01(n). Accordingly, the claims 10-13 have not been further treated on the merits.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 recites the limitation "the firing trigger" in line 8. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 20 is rejected under 35 U.S.C. 102(b) as being unpatentable over Olson et al. (USPN 5,307,976).

In reference to claim 20, Olson et al. discloses a surgical instrument, comprising: an end effector (140) responsive to a longitudinal firing motion, a firing actuator (114) configured to produce the firing motion, a plurality of linked members (114, 145, 146) coupled to the end effector (140) to transfer the longitudinal firing motion; and a firing mechanism (144) coupled to a firing trigger (114) and selectively

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engageable to the linked members (145, 146) to transfer the firing motion from the firing trigger (114) through the plurality of linked members (145, 146) as a distally moving longitudinal motion.

*Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 21 and 22 are rejected under 35 U.S.C. 102(b) as being unpatentable over Olson et al. (USPN 5,307,976) in view of Smith et al. (USPN 4,796,793).

Regarding claim 21, Olson et al. discloses a surgical device having a plurality of linked members (146, 148) responsive to a firing trigger (114), but only discloses one (148) of the link members as being pivotally connected. Smith et al. teaches an instrument having a firing actuator (81) engageable with a plurality of pivotally linked members (76, 77, 80) to transfer a firing motion to a firing mechanism (95). It would have been obvious to one having ordinary skill in the art to modify the linked members of Olson et al. to the pivotally connected linked members of Smith et al. for the purpose of reducing the range or extent of force required to mobilize the firing actuator (Smith et al.-column 15 lines 53-57).

With respect to claim 22, Olson et al. in view of Smith et al. does not disclose clevis style pivotal connections. It would have been an obvious matter of design choice to modify the pivotal connection so Olson et al. in view of Smith et al. include a clevis, since applicant has not disclosed that this specific junction solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the pivotal connections shown disclosed by Olson et al. in view of Smith et al.

*Allowable Subject Matter*

8. Claims 1-19 and 24 are allowed.

The following is an examiner's statement of reasons for allowance: The art of record considered as a whole, alone or in combination, neither anticipates nor renders obvious a surgical instrument comprising a rack means responsive to a firing mechanism, the rack means formed of a plurality of links, pivotally connected links, or being bendably retractable.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

9. Claim 23 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The art of record considered as a whole, alone or in combination, neither anticipates nor renders obvious a surgical instrument comprising a plurality of pivotally connected linked members engageable with a firing trigger to transfer a firing motion to a firing mechanism, the pivotal connection positioned offset from a longitudinal axis wherein adjacent linked members include abutting surfaces when in a straight alignment, preventing pivotal movement of the linked members.

*Conclusion*

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Refer to attachment for notice of references cited and recommended for consideration based on their disclosure of limitations of the claimed invention.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gloria R Weeks whose telephone number is (703) 605-4211. The examiner can normally be reached on 7:30 am - 6:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott A Smith can be reached on (703) 308-2190. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gloria R Weeks  
Examiner  
Art Unit 3721



grw  
September 23, 2004



SCOTT A. SMITH  
PRIMARY EXAMINER